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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225613
Party	Defendant AAF Nation, LLC
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Date	08/16/2016
Attachments	SEMPER SILKIES.pdf(12271 bytes) Exhibit A.pdf(3267332 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

M.J. Soffe, LLC

Opposer

v.

AAF Nation, LLC

Applicant

Opposition No. 91225613

**APPLICANT AAF NATION'S LLC MOTION TO SUPPLEMENT
MOTION TO SUSPEND OPPOSITION**

Applicant AAF Nation, LLC ("AAF"), by and through its attorneys, Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C., respectfully supplements its "Motion to Suspend Opposition" filed Friday, August 12, 2016.

AAF hereby submits a copy of the pleadings as Exhibit A from the Civil Action proceeding between AAF and M.J. Soffe ("Soffe") in the United States District Court for the Southern District of California (Case No. 3:16-cv-02048-LAB-KSC), commenced on August 12, 2016.. Pursuant to 37 C.F.R. § 2.117(a), "proceedings before the Board may be suspended until termination of the civil action" whenever "it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case." *See* TMBP § 510.02(a); *Gen. Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q. 2d 1933 (TTAB 1992); *Other Tel. Co. v.*

Connecticut Nat 'I Tel. Co., 181 U.S.P.Q. 125 (TTAB 1974); *Tokaido v. Honda Assocs. Inc.*, 179 U.S.P.Q. 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805 (TTAB 1971).

AAF respectfully requests that the Board grant this motion and suspend this Opposition proceeding pending disposition of the district court action.

Respectfully submitted,

By: /Andrew D. Skale/
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Attorneys for Respondent
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Dated: August 16, 2016

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on August 16, 2016, a true copy of this document was served on counsel for the Applicant by delivering the same via First Class U.S. Mail, postage prepaid, to:

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AAF NATION, LLC

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

AAF Nation, LLC, a Maryland Limited
Liability Company,

Plaintiff,

vs.

M.J. Soffe, LLC, a North Carolina
Limited Liability Company,

Defendant.

Case No. '16CV2048 LAB KSC

**PLAINTIFF AAF NATION, LLC'S
COMPLAINT FOR:**

- 1) TRADEMARK INFRINGEMENT;**
- 2) FEDERAL UNFAIR
COMPETITION; AND**
- 3) STATUTORY AND COMMON
LAW UNFAIR COMPETITION**

AAF Nation, LLC ("AAF" or "Plaintiff") brings this suit for trademark infringement, federal unfair competition, and common law unfair competition against M.J. Soffe, LLC. ("M.J." or "Defendant") and alleges as follows:

THE PARTIES

1. AAF Nation, LLC is a Maryland limited liability company with its principal place of business at 13514 Waterford Hills Boulevard, Maryland 20874.

2. Upon information and belief, M.J. Soffe, LLC is a North Carolina Limited Liability Company with its principal place of business at One Soffe Drive, Fayetteville, North Carolina 28312.

1 to 2014, AAF had actively developed, marketed, and used the marks at issue in this
2 case.

3 12. AAF has developed a successful clothing line, including two brands of
4 men's versatile running shorts known as SEMPER SILKIES and RANGER
5 PANTIES. *See* Exhibits A, B.

6 13. Given the importance of the brands RANGER PANTIES and SEMPER
7 SILKIES, AAF filed for U.S. trademark applications on March 13, 2015.

8 14. The U.S. Patent and Trademark Office assigned AAF Application Serial
9 No. 86563263 for the RANGER PANTIES word mark and Application Serial No.
10 86563273 for the SEMPER SILKIES design mark (collectively, "RANGER marks").

11 15. M.J. opposed the RANGER marks by filing Opposition Nos.
12 91225613 and 91225278 with the USPTO. In doing so, M.J. admitted to its use and
13 interest in use of both of the RANGER marks in commerce.

14 16. The pending trademark applications for the RANGER marks covers the
15 following goods and services: "Clothing, namely, shorts, shirts, T-shirts, jackets, hats
16 and caps, baseball caps and hats, button down shirts, caps, caps with visors, coats,
17 coats for men and women, headgear, namely, hats, caps and visors, hooded pullovers,
18 hooded sweat shirts, long sleeve pullovers, polo shirts, pullovers, short-sleeved or
19 long-sleeved T-shirts, short-sleeved shirts, tank tops, men's and boy's underwear,
20 namely, briefs, and athletic underwear, undershirts, sleepwear and sleep shirts,
21 pajama tops, pajama bottoms, daywear, namely, bikinis, ladies' panties, crop tops,
22 and leggings, halter tops, jerseys" in International Class ("IC") 025.

23 17. The applications for the RANGER marks have been published by the
24 USPTO, meaning that the USPTO has found the RANGER marks to be inherently
25 distinctive for the goods identified.

26 18. That is because, in fact, the RANGER marks are valid and protectable
27 marks.
28

1 19. On information and belief, Defendant M.J. has conducted online sales
2 and has distribution center in California.

3 20. On information and belief, M.J. manufactures, advertises, and sells
4 men's running shorts known as "MJ Soffe Men's Running Short." Until recently,
5 M.J. marketed its running shorts under its official line, XT-46. *See* Exhibit C.

6 21. On information and belief, M.J. has recently started using the RANGER
7 marks in its marketing of its running shorts. *See* Exhibit D.

8 22. On information and belief, M.J. had first learned about AAF's SEMPER
9 SILKIES and RANGER PANTIES sometimes between 2010 and 2012.

10 23. On information and belief, M.J. also publicly acknowledged AAF's
11 SEMPER SILKIES in or around March of 2014 and complimented AAF on its work
12 in social media.

13 24. On information and belief, M.J.'s Board of Directors had further learned
14 about AAF's SEMPER SILKIES and RANGER PANTIES in or around February of
15 2015, had reviewed AAF's website at that time, and had decided to deliberately
16 compete with AAF by using AAF's successful RANGER marks for its own products.

17 **FIRST CAUSE OF ACTION**

18 **TRADEMARK INFRINGEMENT**

19 **(15 U.S.C. § 1125 *et seq.*)**

20 25. AAF incorporates by reference all other paragraphs contained in this
21 Complaint.

22 26. AAF's RANGER marks are inherently distinctive.

23 27. AAF's RANGER marks have achieved market penetration throughout
24 the United States and, at a minimum, in California.

25 28. AAF substantially used its RANGER marks in commerce before M.J.
26 used the RANGER marks. Its market penetration was prior to M.J.'s first use of the
27 infringing RANGERS marks.

1 29. M.J.'s RANGER marks are identical or substantially similar in sound,
2 appearance and meaning to AAF's RANGER marks.

3 30. M.J. has used the RANGER marks or confusingly similar variations of
4 them, in connection with the sale, offering for sale, distribution or advertising of
5 goods and/or services that are related to and directly compete with AAF's services.

6 31. The use of the Ranger marks by M.J. is likely to cause confusion with
7 AAF's RANGER mark for reasons including, but not limited to:

- 8 a. The RANGER marks are inherently distinctive;
- 9 b. The RANGER marks are nearly identical in sight, sound and meaning;
- 10 c. Upon information and belief, evidence of actual confusion exists and
11 continues to permeate AAF's marketing efforts, with consumers
12 indicating a lack of appreciation for the differences between the two
13 trademarks; and
- 14 d. M.J. intends to directly compete with AAF online and in physical store
15 locations.

16 32. M.J.'s wrongful use of the RANGER marks constitutes trademark
17 infringement of AAF's RANGER marks, has caused significant confusion in the
18 marketplace, and is likely to cause both confusion and mistake, along with being
19 likely to deceive consumers.

20 33. M.J.'s infringement of AAF's marks was willful and with knowledge
21 that its use of the RANGER marks would or was likely to cause confusion and
22 deceive others.

23 34. As a direct and proximate result of M.J.'s trademark infringement, AAF
24 has been damaged within the meaning of 15 U.S.C. § 1125 *et seq.*

25 35. AAF has suffered damages in an amount to be established after proof at
26 trial.

1 36. AAF is further entitled to disgorge M.J.'s profits for its willful sales and
2 unjust enrichment.

3 37. AAF's remedy at law is not adequate to compensate for injuries inflicted
4 by M.J. Thus AAF is entitled to temporary, preliminary, and permanent injunctive
5 relief.

6 **SECOND CAUSE OF ACTION**

7 **FEDERAL UNFAIR COMPETITION**

8 **(15 U.S.C. § 1125 *et seq.*)**

9 38. AAF incorporates by reference all other paragraphs contained in this
10 Complaint.

11 39. M.J. has committed acts of unfair competition under 15 U.S.C. § 1125 *et*
12 *seq.*, including the practices and conduct referred to above. Not only does the
13 conduct alleged constitute trademark infringement, but M.J.'s online marketing also
14 purposefully attempts to heighten the likelihood that consumers will be confused, and
15 an inaccurate appearance of affiliation will be created.

16 40. As a direct and proximate result of M.J.'s wrongful acts, AAF has
17 suffered and continues to suffer substantial pecuniary losses and irreparable injury to
18 its business reputation and goodwill. As such, AAF's remedy at law is not adequate
19 to compensate for the injuries inflicted by M.J. Accordingly, AAF is entitled to
20 temporary, preliminary, and permanent injunctive relief.

21 41. By reason of such wrongful acts, AAF is and was, and will be in the
22 future, deprived of, among others, the profits and benefits of business relationships,
23 agreements, and transactions with various third parties and/or prospective business
24 relationship. M.J. has wrongfully obtained profit and benefits instead of AAF. AAF
25 is entitled to compensatory damages and disgorgement of M.J.'s said profits, in an
26 amount to be proven at trial.

THIRD CAUSE OF ACTION

**STATUTORY (Cal. B&P 17200 *et seq.*) AND COMMON LAW UNFAIR
COMPETITION**

42. AAF incorporates by reference all other paragraphs contained in this Complaint.

43. By offering virtually identical services under a virtually identical mark, M.J. has passed off its services as those of the senior user, AAF.

44. M.J. has committed acts of unfair competition, including the practices and conduct referred to in this Complaint. These actions constitute unlawful, unfair or fraudulent business acts or practices, and/or unfair, deceptive, untrue or misleading business practices. The actions were done in connection with sales or advertising.

45. As a direct and proximate result of M.J.'s wrongful acts, AAF has suffered and continues to suffer substantial pecuniary losses and irreparable injury to its business reputation and goodwill. As such, AAF's remedy at law is not adequate to compensate for injuries inflicted by M.J. Accordingly, AAF is entitled to temporary, preliminary, and permanent injunctive relief.

46. By reason of such wrongful acts, AAF is and was, and will be in the future, deprived of, among other damages, the profits and benefits of business relationships, agreements, and transactions with various third parties and/or prospective business relationships. M.J. has wrongfully obtained profit and benefits instead of AAF. AAF is entitled to compensatory damages and disgorgement of M.J.'s said profits, in an amount to be proven at trial.

47. Such acts, as alleged above, were done with malice, oppression and/or fraud, thus entitling AAF to exemplary and punitive damages.

WHEREFORE, Plaintiff demands the following relief for each cause of action unless otherwise noted:

1. A judgment in favor of AAF and against M.J. on all counts;

2. A preliminary and permanent injunction from trademark infringement and unfair business practices by M.J.;
3. Damages in an amount to be determined at trial;
4. M.J.'s unjust enrichment and/or disgorgement of M.J.'s profits;
5. Trebling of damages for willful infringement and unfair competition;
5. Exemplary and punitive damages (except as to relief for Cal. B&P 17200 *et seq.*);
6. Pre-judgment interest at the legally allowable rate on all amounts owed;
8. Costs and expenses;
- 9 Attorney's fees and other fees under, among others, 15 U.S.C. § 1117(a) *et seq.* as an exceptional case;
10. Opposition Nos. 91225613 and 91225278 to be dismissed and federal registrations for AAF's RANGER marks to be allowed to proceed to registration;
11. Restitution; and
12. Such other and further relief as this Court may deem just and proper.

Dated: August 12, 2016

MINTZ LEVIN COHN FERRIS GLOVSKY
AND POPEO PC

By /s/ Andrew D. Skale, Esq.

Andrew D. Skale, Esq.

Natalie A. Prescott, Esq.

Attorneys for Plaintiff
AAF Nation, LLC

DEMAND FOR JURY TRIAL

Plaintiff hereby demands a jury trial as to all issues that are so triable.

Dated: August 12, 2016

MINTZ LEVIN COHN FERRIS GLOVSKY
AND POPEO PC

By /s/ Andrew D. Skale, Esq.

Andrew D. Skale

Natalie A. Prescott

Attorneys for Plaintiff

AAF Nation, LLC

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EXHIBIT A



Ranger Panties

RangerPanties.com exists to promote the worlds most versatile pair of shorts - Ranger Panties.

#1 for best peaches and cream builds

#1 for being Bill StearnsGut

#1 in best trajectory between the booty Rex and freedom

BUY NOW

News

Photos of people doing American things in Ranger Panties - the most versatile pair of shorts in the world

OH, YOU TOUCHED MY TRALALA.

THOSE ARE SOME EXTENSIVE WARMUPS.


IT'S LIKE A SHIRT IS NOT PART OF THE RPS

EXHIBIT B

https://www.aafnation.com/products/semper-silkies?variant=6551760385

AMERICAN
HOME COLLECTIONS GEAR CONTACT WHOLESALE PRESS ABOUT US SUBMIT YOUR IDEA

CREATE ACCOUNT LOGIN Search Products 90




Semper Silkies! (Free Shipping)
~~\$ 24.99~~ -20%
\$ 19.99

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★★★★★ 23 Reviews

FREE SHIPPING




These shorts are the best thing to happen to me since the creation of democracy. Nothing screams freedom like your bits and pieces being gently cradled by these justice-inducing booty shorts while your downstairs mix-up to thrust into the face of every angry protester and nut job you see as they grimace with jealousy!

Select Your Style



S M L XL 2XL




View Size Chart

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EXHIBIT C



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LADIES


JUNIORS

KIDS

NEW

CLEARANCE

SOFFE HOME :: MENS - COLLECTIONS - MILITARY :: XT46 RUNNING SHORTS BY SOFFE #M020







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XT46 RUNNING SHORTS BY SOFFE

\$12.99

CHOOSE A COLOR



COLOR

SIZE

S

M

L

XL

Size Chart

EXHIBIT D

